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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,295	12/11/2000	George Bradley Hobbs	10003974-1	3877

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O.Box 272400
Fort Collins, CO 80527-2400

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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10/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/734,295

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Examiner acknowledges and appreciates that the applicant has amended the claims to include the objected subject matter in the independent form. However the further interpretation of the claims and the prior art cited (Kawai et al, US patent 6,404,994), would in fact reads on the claimed invention the passage on the abstract, lines 11-21, where the copy machine displays the image for the user to select from the plurality of advertisement to be included in the print job, the act of displaying the advertisement would be considered here as the querying or questioning the user of the choices given by the machine to the user to select and confirm the selection, also note column 12, lines 27-56 where the same process is being used to query or in this case ask the user for the selection of advertisements.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 15 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawai et al (U.S. patent 6,404,994)

Regarding claim 15 and 25 Kawai et al disclose: A method of processing a print job of a customer and including advertising with the print job; the method comprising the steps of: defining a print processing system controller having a plurality of advertisements registered therewith (note abstract, lines 12-15, also note column 6, Fig.4, lines 49-53) each of the advertisements having a profile associated therewith (note Abstract, lines 16-18 where the copying machine displays a plurality of printable selection candidates from the plurality of advertisements) defining a network communication link between the customer and the print processing system controller (note column 8 lines 25-35, where the coping machines are connected to the customer through the network) receiving a data file for the print job from the customer at the print processing system controller via the network communication link (note again column 8 lines 25-35) processing the data file for the print job and determining from the data file a content of the print job (note column 8, lines 49-62, also note column 9 lines 23-34) and associating at least one of the advertisements with the print job (note column 8 lines 52-57) including automatically selecting the at least one of the advertisements based on the content of the print job and the profile of the advertisements (note column 16 lines 4-13, also note column 10 lines 49-58) and wherein the step of associating the at least one of the advertisements includes querying the customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job if the response is favorable (note Abstract, lines 11-21, where the copy machine displays the image for

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the user to select from the plurality of advertisement to be included in the print job, the act of displaying the advertisement would be considered here as the querying or questioning the user of the choices given by the machine to the user to select and confirm the selection, also note column 12, lines 27-56 where the same process is being used to query or in this case ask the user for the selection of advertisements).

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 703-306-3487. The examiner can normally be reached on Mon-Fri, 8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Saeid Ebrahimi

Application/Control Number: 09/734,295

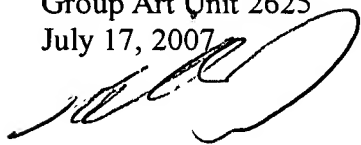
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Patent Examiner

Group Art Unit 2625

July 17, 2007

A handwritten signature in black ink, appearing to be a stylized 'M' or 'D' with a large loop at the end.